



Michigan Department of
Consumer & Industry Services
Bureau of Commercial Services
Corporation Division

TRADEMARKS AND SERVICE MARKS: A GENERAL OVERVIEW

Authorized pursuant to Act 242, P.A. 1969

General Telephone Numbers

<http://www.cis.state.mi.us/bcs/corp>

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General CIS Information (517) 373-1820

General Labor Information (517) 322-1287

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Lansing, Michigan 48909

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Corporation Division (517) 241-6400

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Trademark/Service Mark Information (517) 241-6400

Trademark/Service Mark Forms Request (517) 241-6450

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Treasury Building

Lansing, Michigan 48909

U.S. Department of Commerce

The Patent and Trademark Office (800) 786-9199

General Information

The Patent and Trademark Office

Washington D.C. 20231

Great Lakes Patent and Trademark Center at the Detroit Public Library

General Information (313) 833-3379

5201 Woodward Avenue

Detroit, Michigan 48202

The following information regarding trademarks, service marks and trade names is presented to provide the reader with a clearer understanding of what marks are, what functions they serve, and the benefits and obligations associated with registering a mark. This brochure is not intended to be a substitute for legal counsel. You should consult an attorney to determine whether mark registration is appropriate, and your rights and obligations as the owner of a registered mark.

What is a trademark, service mark and a trade name?

The distinctions between a trademark, service mark and trade name are important in understanding the functions each serves. Michigan law defines a **trademark** as “any word, name, symbol, or device, or any combination thereof, other than a trade name in its entirety, adopted and used by a person to identify **their goods** and to distinguish them from similar goods made or sold by others”. A **service mark** is defined as “any word, name, symbol or device, or any combination thereof, other than a trade name in its entirety, adopted and used by a person in the sale or advertising of services to identify **their services** and distinguish them from similar services of others”. A **trade name** is defined as “any word or group of words used by any person to identify a sole proprietorship, firm, partnership, corporation, association, union, or other organization”. Normally, a trademark appears on the product or on its packaging, while a service mark appears in advertising for the services. A trade name is an actual or assumed name of a business entity, not a name for a specific product or service. In this brochure, the terms “trademark” and “mark” are used to refer to both trademarks and service marks.

What function does a mark serve?

A **trademark** serves primarily to distinguish one producer’s goods or products from similar goods produced by another. Trademarks can also be used to show that goods are from a single source and are of consistent quality. Trademarks reflect the goodwill or integrity of a particular organization.

The primary function of a **service mark** is to distinguish a given service provided by one business from similar services provided by another, or to distinguish the advertising or sales promotion of an organization. Service marks can also be used to show that services are from a single source and are of a consistent quality. Service marks, like trademarks, also reflect the goodwill or integrity of a particular organization.

In contrast to trademarks and service marks, a **trade name** functions to identify a business entity and to distinguish it from other business entities regardless of what goods or services are provided. Unlike some other states, Michigan does not have a central registration of trade names. Sole proprietorships (e.g., ownership by one individual) using an assumed name and general partnerships register with the county clerk. Corporations (profit, nonprofit, ecclesiastical and professional service), limited liability companies, limited liability partnerships and limited partnerships file with the Corporation Division of the Bureau of Commercial Services. For more information please contact the Corporation Division and request a copy of our Entrepreneur’s Guide. The Guide and other related information can also be found at the bureau’s website <http://www.cis.state.mi.us/bcs/corp>. A list of registered marks in Michigan can also be accessed on the website.

What act governs Michigan mark registration?

In Michigan, mark registration is governed by the Trademarks and Service Marks Act, 1969 P.A. 242 as amended. The Michigan Act is modeled after the federal law governing trademarks (the Lanham Act). The Michigan Act provides for the registration of trademarks and service marks, prescribes the powers and duties of certain officers and agencies, and the remedies for infringement. The Act discusses prohibited marks, the registration and renewal process, the assignment of marks, cancellation, and classifications for trademarks and service marks. To obtain a copy of the statute please call (517) 241-6450 or access our website.

Why should I register a mark in Michigan?

Federal trademark registration is only available for marks used in interstate commerce. For a business planning to operate only in this state, registration in Michigan provides notice to others and will provide some protection against infringement. The state-wide registration will help ensure that the time and money put into advertising and establishing a firm’s reputation benefits the firm, not the competition. Registration is helpful for any firm in a highly competitive industry where recognition is vital. Registration, however, does not preclude an opposing party

from asserting any legal or equitable defense or defect which might have been asserted if mark was not registered.

Nothing contained in this Michigan trademarks and service marks act shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law.

Who may register a mark in Michigan?

An application to register a mark may be filed by the owner of a mark in use in Michigan, who may be an individual, firm, partnership, corporation, limited liability company or other organization. The owner of the mark controls the nature and quality of the goods or services identified by the mark. The registration of a mark can be transferred to a successor at any time by filing an Assignment of Trademark/Service Mark Form and paying the required fee.

How do I register a mark in Michigan?

The Corporation Division distributes and processes the application for mark registration. While this application is very simple, it must be filed out accurately and all information must be complete. To obtain an application please call (517) 241-6450 or download the form from our website.

Once the application is completed, return it to the division with two 8 ½" X 11" or smaller samples (copies) of the mark **as used** by the applicant, and the nonrefundable \$50 filing fee. The Bureau's optical imaging system **cannot** accept certain items, i.e., black backgrounds, actual articles such as clothing or photographs. Please call the Corporation Division at (517) 241-6400 if you have any questions pertaining to allowable samples. It should be noted that the Act requires that a mark be **used** in commerce to offer goods or services **before** a registration application can be filed. Applications are examined for accuracy, completeness, and the distinctiveness of the mark.

Why would my mark not be registered?

Section 2(f) of the Act states that a mark shall not be registered if the mark "consists of or comprises a mark which resembles a mark registered in this state, or a mark or trade name as to be likely, when applied to the goods and services of the applicant, to cause confusion, mistake, or to deceive." Thus the Act prohibits the registration of a mark that is confusingly similar to a registered mark or to a corporation, limited liability company, limited liability partnership, limited partnership, general partnership or a sole proprietorship name. Appearance, sound, meaning and goods or services to which the mark applies may be considered in determining if the mark is confusingly similar to an existing mark or name.

In evaluating an application, a search of registered marks is conducted and the applicant is notified if a conflicting mark is found. The principal factors that are considered in reaching a decision are the similarity of the marks and the commercial relationship between the goods and services identified by the marks. To conflict, the marks need not be identical, and the goods and services do not have to be the same.

It should be noted that while a trademark may be distinguishable on our record, this difference might not be enough to avoid infringing on business names filed with the county clerk or the Bureau, or nationally registered trademarks and service marks. If an infringement does occur, the applicant could be sued and forced to pay damages for infringement to the person or entity which has superior legal rights to the mark. The responsibility to avoid infringement rests with you, and care should be taken in choosing a mark.

How do I avoid infringing on another entity's name or mark?

To avoid infringing on another entity's name or mark, a diligent search of entities names and mark should be conducted. The search may include state registered marks, federally registered marks, domain names, names of sole proprietorships and partnerships, and names of corporations, limited partnerships and limited liability companies.

A list of Michigan registered marks is available on the web site at <http://www.cis.state.mi.us/bcs/corp/pdf/markcom.pdf>. In addition, a request for the search of Michigan registered marks may be submitted by mail to the Corporation Division.

Search for federal trademark registration may be conducted at either the U.S. Patent and Trademark Office (PTO) or the Great Lakes Patent and Trademark Center at the Detroit Public Library. The Great Lakes Patent and Trademark Center is a partnership between the PTO and the Detroit Public Library and was established to provide fast, convenient patent and trademark service to the Great Lakes region. Services offered include assistance in basic patent and trademark searches, seminars on issues related to intellectual property and document delivery of U.S. patents and trademarks. For specific information, or if you have any questions please call the Great Lakes Patent Trademark Center at (313) 833-3379, visit their website at <http://www.detroit.lib.mi.us/glptc/> or write to Great Lakes Patent and Trademark Center, Detroit Public Library, 5201 Woodward Ave., Detroit, MI 48202.

You may also contact the United States Patent and Trademark Office at (800) 786-9199 or (703) 308-4357 or write US Patent and Trademark Office, Crystal Plaza 2, Room 2C02, Washington, DC 20231.

Assumed names of sole proprietorships and copartnership names are filed with the county clerk in each county in which business is conducted. Contact the county clerk's office in any county in which business will be carried on to determine if a name similar to the proposed mark is currently on file for a sole proprietorship or partnership. There is a list on counties on the state's web site at <http://www.michigan.gov/emi/1,1303,7-102-116-2746--00.html#MichiganCounties> with links to county web sites.

Michigan corporation, limited partnership and limited liability company names and the names of foreign corporations, limited partnerships, and limited liability companies with authority to transact business in the state may be searched on the web at http://www.cis.state.mi.us/bcs_corp/sr_corp.asp. In addition, the Customer Service Unit of the Corporation Division may be contacted by phone, fax or mail to check names of these types of entities.

Checking all of these sources does not guarantee that you are not infringing on another mark or name, but it does offer an opportunity to decrease the chances significantly. It is important that you should be aware that regardless of whether there are any grounds for objections under the statutes we administer, if you adopt a mark which misleads the public into believing that your business is that of another business, you may be liable for legal action by the person whose business you have affected. If you desire further assurance that your mark does not infringe on the rights of other business entities, there are professional search firms who will attempt to do a comprehensive search for a fee.

How do I make my trademark distinctive?

The purpose of trademarks and service marks is to make goods and services from one source distinguishable from others. Thus, a mark which is creative and unique will serve its function most effectively because the mark will stand out and leave an impression on the consumer. A creative or unique mark could include a made up word that is new to the language, fanciful use of a word, or a common word that is not generally associated with the particular good or service. It can also include a term which is suggestive, requiring some thought or imagination on the part of the consumer to see the descriptive connection of the mark. Any mark which is determined to be distinctive is eligible for registration upon use, and affords a greater degree of protection against infringement.

While it is common for a business to initially try to use a mark that describes some characteristic of the good or service being provided, this type of mark will usually not serve the function of a mark. A mark which simply describes the type of product will not stand out, especially when there are many other similar goods or services and probably will not leave an impression in the consumer's mind distinguishing that product from others. A mark will be considered descriptive if it describes the intended purpose, function or use of the goods or services; the size of goods; the class of users; a desirable characteristic; or the end effect upon the user. Descriptive marks are harder to register because the mark is descriptive, then competitors should not be excluded from using terms and symbols that accurately describe their goods and services.

Problems also arise when a business tries to register a geographically descriptive mark. Such geographically descriptive marks can include streets, cities, states, nations and continents. Geographically descriptive marks

cannot usually be registered. Competitors should not be restricted from accurately describing the location of where their goods or services are produced or sold.

A descriptive or geographically descriptive term cannot be registered unless the term has become so closely associated with a particular good or service that consumers no longer see the term in its typical descriptive meaning, but as an indication of a single source for a good or service. This mental association in the buyer's minds between the mark and a single source is an indication that the mark has become distinctive, or has gained secondary meaning apart from the dictionary definition of the descriptive term. The mark is registrable once it has become distinctive. The consumer's association between the good or service and the descriptive or geographically descriptive mark necessary to show this distinctiveness can be achieved through continuous use of the mark for many years, and/or strong advertising and promotional campaigns linking the mark and the producer. Under state and federal law, a mark is considered to have become distinctive after five years of uninterrupted use.

How do I maintain my trademark registration?

Trademark rights can last indefinitely if the owner continues to use the mark to identify its goods or services. The term of a Michigan trademark registration is 10 years, with ten year renewal terms. A renewal application will be sent to the original applicant six months before the renewal is due must be returned to the Bureau within the six month renewal period. To ensure the renewal application is received the mark holder should make sure the agency has its current address.

Who can use the symbols "TM" or "SM"?

Anyone who claims rights in a mark may use the "TM" (Trademark) or "SM" (Service Mark) designation with the mark to alert the public to the claim. It is not necessary to have a registration, or even a pending application to use these designations. The claim may or may not be valid depending if anyone else has a claim to the mark. The registration symbol, ®, may only be used when the mark is registered with the U.S. Patent and Trademark Office.

When should an entity register at the federal level?

Registration at the federal level should be considered if the mark will be used in interstate commerce. For example, a small business which is expanding or a large business operating in many states. Federal registration offers a broader level of protection than is afforded by state registration. State trademark registration cannot override or restrict federal registration, and in cases where there is a discrepancy between federal and state law, federal law will generally pre-empt state law.

The laws governing the registration of trademarks and service marks are similar at the federal and state level. At the federal level, registration is governed by the Lanham Act. This Act describes registration requirements, provides the remedies in cases of mark infringement, and prescribes the duties of the U.S. Patent and Trademark Office in the registration process, including registration fees. If you have any questions or would like a copy of the Lanham Act or an application to register a federal trademark, please contact the PTO at (800) 786-9199 or at their website at <http://www.uspto.gov/>. You can also obtain the same information from the Great Lakes Patent and Trademark Center at the Detroit Public Library.

What is my obligation as a mark owner?

The primary obligation of a mark owner is to take action against all infringers, no matter how unimportant a particular instance of infringement may seem. Protection of the mark cannot be selective. In order to ensure equitable justice in cases of infringement, the owner must be consistent in asserting the rights of ownership. If action is not consistent or not taken in a reasonable amount of time, the owner may be deemed to have waived the right to enforce trademark rights.

What are the benefits of having a registered mark?

A registered mark can help a business establish and symbolize its good will, which is very important in a highly competitive market. The mark may distinguish the firm's product or service and assure customers that the firm

stands behind the product or service. A registered mark aids in packaging and advertising, promotion and consumer recognition. A mark can also help the firm encourage customer loyalty if the mark signifies quality.

Owning a registered mark may protect a firm from infringement of its mark by a competitor. The owner of a registered mark should take action against infringers to ensure that the firm benefits from the time and money put into good will and advertising. The act prohibits unauthorized use of a registered mark and provides some remedies. A primary concern in infringement cases is the date of first use. While infringement protection also falls under common law rights, having a mark registered is one way to record the date of first use and provide notice of claim of ownership. Owning a registered mark may also protect the firm from dilution, and provides some remedies. A registered mark can also be used as evidence in court as proof of registrant's right to use the mark in connection with the goods or services specified.

Conclusion

Trademarks and service marks can a valuable asset of a business or organization, and the cost of the registration in Michigan is small compared to the benefits. If a mark is distinctive it can effectively distinguish one firm's product or service from others, and in connection with quality products or services and good advertising, can help a firm's business develop, grow, and prosper.

For more information contact:

State Registration

Michigan Department of Consumer & Industry Services
Bureau of Commercial Services
Corporation Division
P.O. Box 30054
Lansing, MI 48909-7554
(517) 241-6400

Federal Registration

U.S. Department of Commerce
The Patent and Trademark Office
Washington D.C. 20231
(800) 786-9199

Great Lakes Patent and Trademark Center
Detroit Public Library
5201 Woodward Avenue
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